SUMMARY OF THE OFFICE ACTION

1) Claims 1-15 are pending in the application.

2) Claims 2 and 10 have been rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement, asserting that the claimed subject matter was not reasonably described in the specification as filed.

3) Claims 2 and 10 have been rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter regarded as invention asserting that the language of these claims is in conflict with the language of claims 1 and 9, from which they respectively depend.

4) Claim 15 has been rejected under 35 U.S.C. 101 as directed towards non-statutory classes of invention.

5) Claims 1-15 have been rejected under 35 U.S.C. 103(a) as unpatentable over Published US Patent Document 2003/0236116 A1 (Marks) in view of Published Provisional US Patent Document 60/454,822, as shown by 2004/0180714 A1 (Ward).

ARGUMENT

1) Claims 1-15 are pending in the application.

2) Claims 2 and 10 have been rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement, asserting that the claimed subject matter was not reasonably described in the specification as filed.

It is asserted that the term "wherein the probability of winning the jackpot upon the scatter symbols is linearly dependent upon the size of the player's wager" does not comply with the written description requirement of 35 U.S.C. 112, first paragraph.

This rejection is in error. The original specification clearly states on page 1, lines 15-21:

> "Current gaming regulations in many parts of the world require players to be paid returns in proportion to their bet level. For example, if a player plays a single line gaming machine at 1 credit, and achieves 3 `X` symbols on a line and a prize of 5 credits is awarded, then it would be expected that a player achieving the same result and playing 2 credits on the same single line game would be awarded 10 credits. **This is referred to as linearity and ensures all players are paid prizes that are proportionate to their bet level.**"

This paragraph clearly discloses the concept recited in the claims and provides a written description in the original specification for a disclosure of the recited term in the original specification. As the language objected to is in the claims, and the claims are part of the original specification, Applicants have elected to take the limitations in the claims and add the limitations to the above-quoted paragraph in the specification, which was done above in the section of this Amendment titles "In The Specification."

Not only did the original specification meet the requirements of 35 U.S.C. 112, first paragraph, but the amended specification clearly resolves that issue.

3) Claims 2 and 10 have been rejected under 35 U.S.C. 112, second paragraph as failing to particularly point out and distinctly claim the subject matter regarded as

invention asserting that the language of these claims is in conflict with the language of claims 1 and 9, from which they respectively depend.

It is asserted that claims 2 and 10 are in conflict with the language in claims 1 and 9. It is asserted that "…it is unclear [from the different language in claims 2 and 10 from that in claims 1 and 9] whether the size of a player's wager affects the variable state scatter symbol or the probability of winning the jackpot or both."

This rejection is clearly in error. According to required methodology of claim interpretation, claims 2 and 10 must further limit the scope of coverage of claims 1 and 9, from which they depend. Therefore, every limitation in claims 1 and 9 must be practiced and all the limitations of claims 2 and 10 must be practiced for any method to fall within the respective scope of claims 2 or 10.

Therefore, as a matter of law, the scope of coverage of claim 2 [for example] requires that **BOTH** of the features of:

> a) "…wherein the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager;…" and

> b) wherein the probability of winning the jackpot based upon the scatter symbols is linearly dependant upon the size of the player's wager relative to a maximum possible wager.

It is absolutely clear according to standard and required methodology in the reading of claim language that the method of claim 2 and the gaming machine of claim 10 may be infringed only where both of the features a) and b) are practiced. There is no conflict in this language at all. The claims merely state that the size of a player's wager is required to have two separate effects. It is not contradictory for a single step to be required to have two results, unless those results are impossible to perform at the same time (e.g., adding an ingredient to a solution to cause the temperature of the solution to rise and lower). The two requirements are not in conflict. The active state is dependent upon the size of a player's wager. **[claims 1 and 9]** The probability of winning (i.e., when the symbols are active) is linearly dependent upon the size of the player's wager. Both of these steps, as recited, may be practiced without conflict in a method and a game apparatus.

4) Claim 15 has been rejected under 35 U.S.C. 101 as directed towards non-statutory classes of invention.

Claim 15 has been amended to remove this rejection.

5) Claims 1-15 have been rejected under 35 U.S.C. 103(a) as unpatentable over Published US Patent Document 2003/0236116 A1 (Marks) in view of Published Provisional US Patent Document 60/454,822, as shown by 2004/0180714 A1 (Ward).

In responding to this rejection, Applicants will follow the standards of evaluation of a rejection under 35 U.S.C. 103(a) and compare the language of the claims (in this case beginning with claim 1) with the teachings of the primary reference (Marks), determine the differences between Marks and the recited claim, and determine whether the teachings of the secondary reference (Ward) overcomes the deficiencies of Marks and can be combined with the teachings of Marks to show the obviousness of the invention as a whole, as claimed. This procedure will begin with the following table:

CLAIM 1	MARKS	COMMENTS
A method of providing a jackpot in a gaming machine, said machine having multiple simulated reels used to play a game, and at least one pay line,		
including at least the steps of: (a) determining a player's wager;	"…the player determines how many credits he wishes to wager on the next spin of the slot reels."	
(b) playing the game, so that the simulated reels used in the game assume a specific configuration showing symbols across said reels,	"Symbol Matrix. Slot symbols are displayed on 3 or more slot reels (also called "columns") placed adjacent to each other. Each column contains at least 3 rows, with a symbol in each row."	
wherein one or more of said symbols can be a scatter	[0009] Alternatively, players may also collect	

symbol,	credits for predetermined winning combinations that appear anywhere on a pay line ("line scatter pays")	
wherein one or more of said scatter symbols can be a variable state scatter symbol,	**The scatter symbols of Marks are always active scatter symbols.**	**Admitted to be absent from Marks**
said variable state being either an active state, whereby said variable state scatter symbol acts as a scatter symbol,	**The scatter symbols of Marks are always active scatter symbols.**	**Admitted to be absent from Marks**
or an inactive state, whereby said variable state scatter symbol is not considered to be a scatter symbol,	**The scatter symbols of Marks are always active scatter symbols.**	**Admitted to be absent from Marks**
wherein the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager;	A slot machine issues a percentage of one or more progressive awards based upon any wager level ("Percentage Progressive").	
and (c) determining if scatter symbols appear across said reels used in the game in a predefined manner, and if so then paying said jackpot	Wagers are resolved.	

The rejection asserts that paragraph [0061] of Ward discloses "…a game where the paylines can be active or inactive dependent upon the size of the wager…" The rejection asserts that it would be obvious to combine the concept of a "variable symbol/payline dependent on a wager amount as taught by Ward to the game and then add the common practice of scatter symbols (as shown by Marks et al.) to allow the player to increase the probability of winning by wagering a higher amount."

The failure in this rejection is the fact that even if traditionally dispersed scatter pays are added to the system of Ward, that would not provide the subject matter as claimed. **The underlying fact is that Neither Ward nor Marks teaches a variable state scatter symbol. There is no way the two references can be combined to show a specific**

feature that is absent from each of the references. Ward teaches the following, which is approximately and appropriately quoted in the rejection:

> "[0061] In accordance with the game, a winning event of the first or main game results if a predetermined combination of symbols 100 is displayed along an activated or active payline P. **In one embodiment, paylines P are activated depending on the size of the wager or bet which is placed by a player. In one embodiment, all paylines P may be activated when a bet or wager is placed or payment or other entitlement to play the game exists. In another embodiment, only one or a few paylines P are activated when a bet or wager of a first size is placed (or points used), and additional or all paylines P are not activated unless an additional or larger bet or wager is placed (or point used).** In a preferred embodiment, a base bet or wager activates a single payline P, such as payline P1. An additional incremental bet or wager is required to activate each additional payline P2-P8. A maximum bet of eight times the base bet or wager thus activates all of the paylines P1-8. In one embodiment, a base bet or wager may comprise a single coin or denomination (such as U.S. $0.25) or multiple coins (e.g. U.S. $1.00, which is 4.times.$0.25)." (**emphasis** added)

However, the rejection attempts to take the relatively standard method of play of requiring a player to pay for additional paylines and attempts to extend that teaching by equating the "variable state scatter symbols" of the claims of Applicant and paylines from the teachings of Ward to "symbols/paylines" in the rejection. **There is no legal way of equating activation of a specific class of symbols as recited in the claims of Applicant to the activation of an entire payline as taught by Ward.** This is emphasized by the recitation in the claims that the reels are already in play, and that the variable state scatter pays would have to be separately activated (variable state) as by the wager. The scatter pays of Marks are always active. This is clear error and it will be shown that the cited teaching of Ward fails to disclose the subject matter for which it is cited, and that even Ward cannot overcome the deficiencies of marks with respect to the subject matter as a whole as claimed.

Claim 1 specifically recites steps of:

> "...(a) determining a player's wager; (b) playing the game, so that the simulated reels <u>used in the game</u> assume a specific configuration showing symbols across said reels, wherein one or more of said symbols can be a scatter symbol, **wherein one or more of said scatter symbols can be a variable state scatter symbol, said variable state being either**

an active state, whereby said variable state scatter symbol acts as a scatter symbol, or an inactive state, whereby said variable state scatter symbol is not considered to be a scatter symbol, wherein **the probability of a variable state scatter symbol having an active state is dependent upon the size of the player's wager;...**"

Note that the claim language shows that not only scatter symbols are provided in reels **used in the game**, but that the scatter pay symbols are already in reels used in the game (whether dependent on the size of the wager or not), but that the scatter pays, already in reels **used in the game** are active or inactive dependent upon the size of the wager. This is totally different from the teaching of Ward, wherein the reels or paylines are active or inactive (not individual symbols) dependent upon the size of the wager. Under the present description of the steps recited in the claims, the reels are already used in the game (the reels are already active), the symbols including scatter symbols are provided in the reels used in the game (i.e., the reels are already active in the game), and the probability that individual scatter pay symbols are active or inactive varies with the size of the wager.

That mode of play recited in all claims (using various alternative language in claims 1, 7, 10 and 14) is novel and unobvious over the method described by Ward. As the method disclosed by Ward cannot teach the steps recited in these claims. The present claims recite that the activity of symbols provided in reels already used in the game have their activity altered. Ward teaches that the size of a wager will determine how many reels or paylines are used in the game.

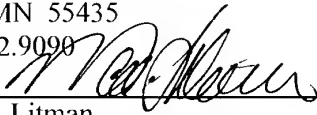The rejection is clearly in error and must be withdrawn.

CONCLUSION

All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.

Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952-832-9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,
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